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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,439	01/19/2001	Robert Betros	43416-0003	7164
33123	7590	04/19/2007	EXAMINER	
HELLER EHRLMAN LLP 4350 LA JOLLA VILLAGE DRIVE #700 7TH FLOOR SAN DIEGO, CA 92122			LIN, KELVIN Y	
			ART UNIT	PAPER NUMBER
			2142	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/19/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/766,439	BETROS ET AL.
	Examiner Kelvin Lin	Art Unit 2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 December 2006.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 12/11/06.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **Detailed Action**

### **Information Disclosure Statement**

1. The information disclosure statement filed on 12/11/06 was not being considered because it fails to comply with the provisions of 37 CFR 1.97, 1.98(a)(2)(ii) and MPEP § 609. The applicants fails to provide a legible copy of listed document. Therefore, the information disclosure statement has not been considered. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Response to Arguments***

1. Applicant's arguments, see Remarks from page 8-14, filed on Dec. 4, 2006, with respect to the rejection under 35 USC 112 1<sup>st</sup> paragraph (no enablement) have been fully considered and are not persuasive for the following reasons.

2. Applicant is arguing the following:

The enablement rejection should be withdrawn because the examiner failed to consider the entirety of the scope of the claims. The applicant is

essentially arguing that because the examiner did not repeat the claim word for word in the enablement rejection that the examiner has not considered the claim as a whole. This argument is without merit based on the reasoning presented in this Office action and the last Office action.

The claims are in fact enabled. In support of this argument, the applicants map the various limitations of the claims to the specification. This argument by the applicant has been considered but is unpersuasive. It is noted that the sections of the specification describe results being accomplished (e.g., the two-way asynchronous communication between the client and web server over the single socket connection and wholly within the single HTTP transaction) but do not describe an implementation that would allow this result to be accomplished. Accordingly, the examiner disagrees that the specification describes a single embodiment that is in fact enabled.

The various undue experimentation factors suggest that the claims are in fact enabled and then proceeds with a discussion of the factors. A discussion of the applicants' arguments is as follows:

As to the factor of the breadth of the claims, the applicants make two points. First, that the examiner failed to consider the entirety of the claims. This argument was addressed above. Second, the applicants stated that the only relevant concern should be whether the scope of enablement provided to one of ordinary skill in the art is commensurate with the scope of protection sought by the claims. The examiner fails to

see the relevance of what appears to be an argument regarding scope of *enablement* to a rejection stating that there is *no enablement*.

As to the nature of the invention, the applicants suggest that because the technology of computer networks has existed since the late 1960's, the nature of the invention suggests that the amount of experimentation is not undue. This argument is in one sense correct. Computer networks were known in the 1960's. However, the examiner would point out that the subject matter of this application, HTTP based systems, was not known in the 1960's. Therefore, the fact that some of the basic underlying network technology may have existed for a long time does not seem germane to the question of more recent technology at issue here.

As to the state of the prior art, the applicants say that they are "perplexed" that more description is required of features that are not known in the art. The examiner fails to how it is unreasonable to expect the applicants to provide more explanation of the features that distinguish the claims from the prior art.

As to the level of skill in the art, the applicants' argue that the level of skill in the art at the time of the invention was high. It is noted that this statement is merely attorney argument without evidence. Argument without evidence is given little weight. Furthermore, the applicants assert

As to the amount of direction provided, the applicants argue that less guidance is needed in this case because computer communications

has been around for over 40 years and computer programming has been around for even longer. The applicants then assert that the art is predictable. As to these arguments, the applicants are merely restating arguments that were addressed above. The applicants finally argue that both the examiner and themselves have pointed to sections of the specification that they argue are enabling. This argument was addressed above as well.

As to the existence of a working example, the applicants argue that working examples, although not disclosed in their specification, existed prior to the filing date of this application. Assuming without conceding that the existence of working examples that were undisclosed in the original patent application is somehow relevant to the question of whether the applicants filed an enabling disclosure, the examiner would note that the applicants have merely argued the existence of working examples without providing any evidence of their existence. Argument cannot take the place of evidence. As to the statement regarding existence of licensees of the present invention, the examiner fails to see how this statement is germane.

As to the quantity of experimentation needed, the applicants assert that since computer programming is a known art, that no experimentation at all would be needed to implement the claimed invention after reading the specification. This statement is merely argument without any supporting evidence. In view of the applicants statements that they have

commercial licensees of the present invention and their natural interest in obtaining a patent, these factors suggest that the applicants are biased. Accordingly, these statements have little probative value.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). The factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue" include, but are not limited to: (a) the breadth of the claims; (b) the nature of the invention; (c) the state of the prior art; (d) the level of one of ordinary skill; (e) the level of predictability in the art; (f) the amount of direction provided by the inventor; (g) the existence of working examples; and (h) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

As to the breadth of the claims, the claims in this application are broad. Essentially all particular implementations for performing two-way asynchronous communication between a client and a server within a single HTTP transaction fall within the scope of the claims. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is *undue*.

As to the nature of the invention, the applicants suggest that because the technology of computer networks has existed since the late 1960's, the nature of the invention suggests that the amount of experimentation is not undue. This argument is in one sense correct. Computer networks were known in the 1960's. However, the examiner would point out that the subject matter of this application, HTTP based systems, was not known in the 1960's. Therefore, the fact that some of the basic underlying network technology may have existed for a long time does not seem germane to the question of more recent technology at issue here. Based on the evidence in the record, the examiner fails to see how this factor is probative of whether or not the amount of experimentation is undue.

As to the state of the prior art, the very features that the applicants argue distinguish the claims from the prior art are those that are not described. A search of the prior art has not disclosed a system as claimed for performing two-way asynchronous communication between a client and a server within a single HTTP transaction. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is *undue*.

As to the level of skill in the art, there is no evidence in the record as to the level of skill in the art other than the applicants' assertion without evidence that the number of skilled people in the art was substantial and that their level of programming skills was high. Argument cannot take the place of evidence, and these statements therefore have little probative value. Based on the evidence in the record, the examiner fails to see how this factor would suggest that the amount of experimentation to make and use the invention is either undue or not undue.

As to the level of predictability in the art, the computer arts are generally considered predictable. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is *not undue*.

As to the amount of direction provided by the inventor, the applicants' attorney pointed to page 3 lines 12-25, page 6 line 11 to page 7 line 24, and page 8 line 12 to page 9 lines 12 in conjunction with the figures as supporting their amendments to the claims during the telephone interview held on June 15, 2006. During that interview, the inventor, Robert Betros, pointed to the client side logic (Fig. 1 elem. 104) and CGI (Fig. 1 elem. 124) in conjunction with Figures 2 and 4 as what implements the claimed invention. Given the inventor's statement in the interview, a review of the specification's disclosure regarding the client side logic and the CGI is important. The specification describes embodiments of dynamically delivered client side logic as applets and Macromedia Shockwave movies (p. 5 lines 10-13). However, the specification then states that these embodiments are merely exemplary and not limiting (p. 5 lines 10-13). The applicants are essentially saying that the client side logic is software. However,

the application only describes generally the functions the client side logic performs but provides no details on the particular software constructs that would be used to implement those functions. The specification describes an embodiment of the CGI as being a servlet, but states that other embodiments are possible (p. 6 lines 3-4). Although the specification generally describes the functions of the CGI, the specification provides no guidance on the specific software constructs that would be used to implement those functions. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is *undue*.

As to existence of working examples, the specification does not describe a working example. Analysis of this factor therefore suggests that the amount of experimentation to make and use the invention is *undue*.

As to the quantity of experimentation needed, there is no evidence in the record indicate the quantity of experimentation that one of ordinary skill in the art would need to implement the present invention. Although the applicants have argued that no experimentation would be required, this statement is merely argument unsupported by any evidence, as discussed above. Based on the evidence in the record, the examiner fails to see how this factor would suggest that the amount of experimentation to make and use the invention is either undue or not undue.

After weighing all of the factors, the totality of the evidence suggests that it would require undue experimentation to make and use the claimed invention. The majority of the factors for which there is evidence suggest that undue experimentation is required. As to other factors, the evidence in the record is insufficient to establish whether the suggest whether that undue experimentation would be required or not. See the discussion of the nature of the invention, the level of ordinary skill in the art, and the quantity of experimentation, above. Furthermore, although a patent need not teach, and preferably omits, what is well known in the art, *in re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984), the corollary to this statement is that a patent discloses more detail concerning the features that distinguish the claimed invention from the prior art. In this regard, the specification's lack of direction, which is discussed above, appears critical. In addition, the need for more description is consistent with the statement of Robert Betros, one of the inventors of the claimed invention, in the telephone interview on June 15, 2006, where he argued that the client side logic and CGI allow for the performing of two-way asynchronous communication.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

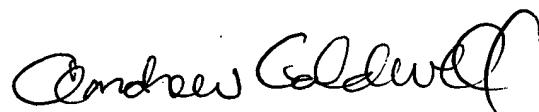
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first replay is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTH from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Lin whose telephone number is 571-272-3898. The examiner can normally be reached on.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/25/06  
KYL



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SUPERVISORY PATENT EXAMINER